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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,338	10/19/1999	SEINOSUKE HORIKI	2710/60471	7137

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NEW YORK, NY 10036

EXAMINER	
KRUER, KEVIN R	

ART UNIT	PAPER NUMBER
1773	

MAIL DATE	DELIVERY MODE
07/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	09/403,338	HORIKI ET AL.
	Examiner	Art Unit
	Kevin R. Kruer	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5-10,12 and 14* is/are pending in the application.

4a) Of the above claim(s) *9,10 and 12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5-8 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 5, 2007 has been entered.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP06270329 (herein referred to as Yuka'329), JP07195870 (herein referred to as Yuka'870, JP08121092 (herein referred to as Yuka'192), or JP05204609 (herein referred to as Yuka'609), in view of Taylor (US 4,292,105) for reasons of record.

Yuka'329 teaches a fibrous material impregnated with a sulfomethylated compound of a condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract).

Yuka'870 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may

be used as a binder in molding fibers, wood chips, and nonwoven fabrics, or as an impregnate or adhesive (page 1 of translation).

Yuka'192 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers, wood chips, and nonwoven fabrics, or as an impregnate or adhesive (page 1 of translation).

Yuka'609 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers (page 1 of translation).

Each Yuka reference teaches the use of said ammonia and/or amine catalyst, the applied art reads on each limitation of the claimed invention ('329-007; '870-008; '092-008; '609-008).

Yuka '329, Yuka'870, Yuka'192, and Yuka'609 do not teach that the resin should be advanced to the B-stage of curing. However, Taylor teaches a fibrous textile impregnated with a thermosetting polymer (col 1, lines 10+). Taylor teaches that the polymerization of the thermosetting polymer should be advanced to the B-stage, because the impregnated material can be stored for a reasonable length of time in that state (col 1, lines 18+). Thus, it would have been obvious to one of ordinary skill in the art to cure the resins taught in Yuka '329, Yuka'870, Yuka'192, and Yuka'609 to the B-

stage after impregnation in order to obtain a product that could be stored fro a reasonable length of time.

4. Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP06270329 (herein referred to as Yuka'329), JP07195870 (herein referred to as Yuka'870, JP08121092 (herein referred to as Yuka'192), or JP05204609 (herein referred to as Yuka'609), in view of Benzinger (US 3,617,613) for reasons of record.

Yuka'329 teaches a fibrous material impregnated with a sulfomethylated compound of a condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract).

Yuka'870 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers, wood chips, and nonwoven fabrics, or as an impregnate or adhesive (page 1 of translation).

Yuka'192 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers, wood chips, and nonwoven fabrics, or as an impregnate or adhesive (page 1 of translation).

Yuka'609 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The

phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers (page 1 of translation).

Each Yuka reference teaches the use of said ammonia and/or amine catalyst, the applied art reads on each limitation of the claimed invention ('329-007; '870-008; '092-008; '609-008).

Yuka '329, Yuka'870, Yuka'192, and Yuka'609 do not teach that the resin should be advanced to the B-stage of curing. However, Benzinger teaches a glass fiber sheet impregnated with a thermosetting resin (abstract). Benzinger teaches that the flow rate of a thermosetting resin can be controlled by polymerizing the polymer to the B stage. Thus, it would have been obvious to one of ordinary skill in the art to cure the resins taught in Yuka '329, Yuka'870, Yuka'192, and Yuka'609 to the B stage in order to control the resin's flow.

5. Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP06270329 (herein referred to as Yuka'329), JP07195870 (herein referred to as Yuka'870, JP08121092 (herein referred to as Yuka'192), or JP05204609 (herein referred to as Yuka'609), in view of Casadevall (US 3,960,626) for reasons of record.

Yuka'329 teaches a fibrous material impregnated with a sulfomethylated compound of a condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract).

Yuka'870 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The

phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers, wood chips, and nonwoven fabrics, or as an impregnate or adhesive (page 1 of translation).

Yuka'192 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers, wood chips, and nonwoven fabrics, or as an impregnate or adhesive (page 1 of translation).

Yuka'609 teaches a sulfomethylated condensation polymer. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers (page 1 of translation).

Each Yuka reference teaches the use of said ammonia and/or amine catalyst, the applied art reads on each limitation of the claimed invention ('329-007; '870-008; '092-008; '609-008).

Yuka '329, Yuka'870, Yuka'192, and Yuka'609 do not teach that the resin should be cured to the B stage. However, Casadevall teaches that the handlability of fiber impregnated with a phenolic resin can be improved by curing to the B stage. Thus, it would have been obvious to one of ordinary skill in the art to cure the resins taught in Yuka '329, Yuka'870, Yuka'192, and Yuka'609 in order to improve their handlability.

6. Claims 6-8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franz et al. (US 3,922,459) in view of JP06270329 (herein referred to as

Yuka'329), JP07195870 (herein referred to as Yuka'870), JP08121092 (herein referred to as Yuka'192), or JP05204609 (herein referred to as Yuka'609) for reasons of record.

Franz teaches a web of fibers impregnated (abstract) with a phenol formaldehyde resin (col 8, line 51). A metal foil may be glued to one or both sides of the impregnated fibers (col 8, lines 32-36).

Franz does not teach that the fibers should be impregnated with the claimed sulfomethylated or sulfomethylated phenolic resin. However, Yuka'329, Yuka'870, Yuka'192, and Yuka'609 each individually teach sulfomethylated condensation polymers. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers (page 1 of translation). Such resins have better pot life and better water solubility than phenol formaldehyde resins. Therefore, it would have been obvious to utilize the sulfomethylated phenolic condensation polymers taught in Yuka'329, Yuka'870, Yuka'192, and Yuka'609 in place of the phenolic formaldehyde resin taught in Franz because such sulfomethylated resins have better pot life and water solubility-thus making processing easier.

With regard to claim 14, the metal layer is understood to be the claimed "base sheet," the glue is understood to read on the claimed "adhesive" and the phenolic resin is understood to read on "the cured material." With regard to the limitation that the resin is at least partially sulfomethylated and/or sulfimethylated "at a time when said phenolic resin is at B-stage," the examiner takes the position that the method of making the product does not patentably distinguish a claimed product from a product taught in the prior art unless it can be shown that the method of making a product inherently results

in a materially different product. In the present application, no such showing has been made.

7. Claims 6-8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US 3,619,342) in view of JP06270329 (herein referred to as Yuka'329), JP07195870 (herein referred to as Yuka'870), JP08121092 (herein referred to as Yuka'192), or JP05204609 (herein referred to as Yuka'609) for reasons of record.

Burke teaches a corrugated fiberboard which resists deterioration in strength when in the presence of water. The board comprises liner members bonded to either side of a corrugate medium that has been treated with phenol aldehyde resole resin (abstract). The phenol aldehyde resole should have a water solubility such that an aqueous solution comprising 55wt% resin solids can be prepared (col 2, line 75).

Burke does not teach that the medium should be impregnated with the claimed sulfomethylated or sulfimethylated phenolic resin. However, Yuka'329, Yuka'870, Yuka'192, and Yuka'609 each individually teach sulfomethylated condensation polymers. The condensation polymer comprises a phenol and aldehyde and/or aldehyde donor (abstract). The phenol aldehyde resin is then cured with an amine compound (abstract). The resin may be used as a binder in molding fibers (page 1 of translation). Such resins have better pot life and better water solubility than phenol formaldehyde resins. Therefore, it would have been obvious to utilize the sulfomethylated phenolic condensation polymers taught in Yuka'329, Yuka'870, Yuka'192, and Yuka'609 in place of the phenolic formaldehyde resin taught in Burke

because such sulfomethylated resins have better water solubility, thus making it easy to prepare an aqueous solution comprising 55wt% resin solids.

With regard to claim 14, the liner members are understood to be the claimed "base sheet," the adhesive (col 6, lines 6+) is understood to read on the claimed "adhesive" and the phenolic resin is understood to read on "the cured material." With regard to the limitation that the resin is at least partially sulfomethylated and/or sulfimethylated "at a time when said phenolic resin is at B-stage," the examiner takes the position that the method of making the product does not patentably distinguish a claimed product from a product taught in the prior art unless it can be shown that the method of making a product inherently results in a materially different product. In the present application, no such showing has been made.

Response to Arguments

Applicant's arguments filed March 7, 2007 have been fully considered but they are not persuasive.

Applicant contends amending claims 1 and 14 to be compositions produced using ammonia and/or amine as a catalyst avoids the pending rejections. The ammonia is stable both below a prescribed temperature and quickly cured above this temperature. According to applicant, this control makes it clear that the invention confers an unusual degree of control since adjusting the addition of ammonia and/or amines as a catalyst enables adjustment to the start temperatures. The prior art relied upon fails to disclose or suggest this concept. The examiner agrees but notes said concept is not implicitly or explicitly claimed. Furthermore, said control does not

inherently distinguish the claimed invention from the invention rendered obvious by the prior art. Since each Yuka reference teaches the use of said ammonia and/or amine catalyst, the applied art reads on each limitation of the claimed invention ('329-007; '870-008; '092-008; '609-008).

For the reasons noted above, the rejections are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KRK

Kevin R. Kruer
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